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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,894	07/06/2001	Craig S. Caldwell	30906	3616

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EXAMINER

SAVAGE, MATTHEW O

ART UNIT PAPER NUMBER

1723

DATE MAILED: 03/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	Application No.	Applicant(s)
	09/899,894	CALDWELL, CRAIG S
Examiner	Art Unit	
Matthew O Savage	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 13 December 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-35 is/are pending in the application.

4a) Of the above claim(s) 10-35 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

Applicant's election with traverse of group I and Species 1 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that : the examiner has not shown that the examination of two groups and four species would impose a serious burden. This is not found persuasive because, as explained in the restriction requirement, the examination of two separate and distinct groups containing divergent subject matter would require two separate searches thereby imposing an undue burden upon the examiner, and the examination of four patently distinct species would require four separate searches also imposing a serious burden upon the examiner.

The requirement is still deemed proper and is therefore made FINAL.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of the media being spaced above the return side inlet as recited in claims 1 and 5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to adequately disclose an embodiment including a return side inlet spaced above the inlet as recited in claims 1 and 5.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding lines 3 and 7 of claim 1, it is unclear as to how the "inlet" and "outlet" are formed since no structure for forming the inlet and outlet has been recited in the claim.

Concerning lines 3, 7, and 12 of claim 5, it is unclear as to how the "sump", "sump inlet", "return side inlet", and "outlet" are formed since structure for forming sump, "sump inlet, return side inlet, and outlet has been recited in the claim.

Regarding lines 5-6 of claim 1 and line 10 of claim 5, it is unclear as to what extent "at least substantially spanning the pan" implies.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowler.

With respect to claim 1, Fowler discloses a pan 22 having a bottom surface (e.g., defined by valleys of the corrugations shown in FIG. 4), an inlet (e.g., the lower end of pipe 32), a filter media 50 spaced above the bottom surface and the inlet (e.g., the portion of media 50 encircling pipe 32 being spaced above the inlet) and at least substantially spanning the pan and operable to filter the return fluid, and an outlet (e.g., the structure forming the channel 26) located above the filter media and operable to release the return fluid.

Concerning claim 2, Fowler discloses spacers (e.g., formed by the corrugations shown in FIG. ) projecting upwardly from the bottom surface of the pan and operable to support the media above the bottom surface.

As to claim 3, Fowler discloses a lid 20 positioned above the media.

Regarding claim 4, Fowler discloses the outlet as comprising a slot in the lid (e.g., defined by channel 26 shown in FIGS. 2 and 3).

With respect to claim 5, Fowler discloses a sump 18 operable to receive fluid via a sump inlet (e.g., defined by the transmission), a return side filter operable to filter the return fluid including a pan 22 having a bottom surface (e.g., defined by the valleys of the corrugations shown in FIG. 4), an return side inlet coupled with the sump inlet (e.g.,

the lower end of pipe 32), a filter media 50 spaced above the bottom surface and the inlet (e.g., the portion of media 50 encircling pipe 32 being spaced above the inlet) and at least substantially spanning the pan and operable to filter the return fluid, and an outlet (e.g., the structure forming the channel 26) located above the filter media and operable to release the return fluid.

Concerning claim 6, Fowler discloses spacers (e.g., formed by the corrugations shown in FIG. 4) projecting upwardly from the bottom surface of the pan and operable to support the media above the bottom surface.

Concerning claim 7, Fowler discloses the return fluid as being released into the sump (e.g., the fluid being released into return conduit 28 which is within the sump).

As to claim 8, Fowler discloses a lid 20 positioned above the media.

Regarding claim 9, Fowler discloses the outlet as comprising a slot in the lid (e.g., defined by channel 26 shown in FIGS. 2 and 3).

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowler.

With respect to claim 1, Pudlo discloses a pan 11 having a bottom surface, an inlet (e.g., passage 17), a filter media 34 spaced above the bottom surface and the inlet (e.g., the media 34 being positioned above the lower portion of passage 17 that is considered an inlet) and at least substantially spanning the pan and operable to filter the return fluid, and an outlet 18 located above the filter media and operable to release the return fluid.

Concerning claim 2, Pudlo discloses spacers 23, 25 projecting upwardly from the bottom surface of the pan and operable to support the media above the bottom surface.

As to claim 3, Pudlo discloses a lid 10 positioned above the media.

Regarding claim 4, Pudlo discloses the outlet 18 as comprising a slot in the lid (see FIG. 2).

Claims 1, 3-5, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Beer et al.

With respect to claim 1, Beer et al disclose a pan 100 having a bottom surface, an inlet (e.g., the spaced below media 105), a filter media 105 spaced above the bottom surface and the inlet and at least substantially spanning the pan and operable to filter the return fluid, and an outlet 108 located above the filter media and operable to release the return fluid.

As to claim 3, Beer et al disclose a lid (e.g., defining outlet 108) positioned above the media.

Regarding claim 4, Beer et al disclose the outlet 108 as comprising a slot in the lid.

With respect to claim 5, Beer et al disclose a sump 100 operable to receive fluid via a sump inlet (e.g., defined by the transmission), a return side filter operable to filter the return fluid including a pan 100 having a bottom surface, an return side inlet coupled with the sump inlet (e.g., the space below media 105), a filter media 105 spaced above the bottom surface and the inlet and at least substantially spanning the pan and

operable to filter the return fluid, and an outlet 108 located above the filter media and operable to release the return fluid.

Concerning claim 7, Beer et al disclose the return fluid as being released into the sump (e.g., port 108, or via conduit 106 which is located within the sump).

As to claim 8, Beer et al disclose a lid (e.g., defining outlet 108) positioned above the media.

Regarding claim 9, Beer et al disclose the outlet as comprising a slot 108 in the lid.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beer et al in view of Pudlo.

Regarding claims 2 and 6, Beer et al fail to specify the recited spacers. Pudlo discloses the concept of providing spacers 23, 25 projecting upwardly from the bottom surface of a pan and operable to support a media above the bottom surface and suggests that such a structure prevents flexing and damage to the filter media. It would have been obvious to have modified the apparatus of Beer et al so as to have included the spacers as suggested by Pudlo in order to prevent flexing and damage of the media.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 6:00am-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Matthew O Savage  
Primary Examiner  
Art Unit 1723

mos  
February 22, 2003